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EXAMINER

COFFY, EMMANUEL

ART UNIT	PAPER NUMBER
2157	

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/891,393

**Applicant(s)**

TOKUE, JUN

**Examiner**

Emmanuel Coffy

**Art Unit**

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 27 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to the application filed on 27 June, 2001. Claims 1-9 are pending. Claims 1-9 are directed to a system for a "Contents Distribution System Portable Terminal Player and Contents Provider."

### ***Oath/Declaration***

2. The oath is objected to as being informal. It lacks authentication by a diplomatic or consular officer of the United States; 37 CFR 1.66(a). This informality can be overcome either by forwarding the original oath to the appropriate officer for authentication or by filing either a declaration under 37 CFR 1.68, or a new properly authenticated oath under 37 CFR 1.66. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. If, however, authentication of the original oath is desired, applicant should request return of the oath for this purpose. Such request must be accompanied by an order for a copy of the oath to be retained in the file until the properly authenticated oath is returned. After the oath has been authenticated, it should be returned promptly to the Patent and Trademark Office. See MPEP §§ 602.01 and 602.02.

### **Specification**

3. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hasegawa et al. (US 6,570,080) in view of Rhoads et al. (US 6,442,285.)

Hasegawa teaches the invention substantially as claimed including a method and apparatus for making sample contents from music contents whereby server and user are connected with each other via a communication network, whereby the server supplies non-sample regular contents including at least performance information of a music piece and sound information pertaining to the music piece and sample contents including a sample of part of the non-sample regular contents. (See abstract).

Claim 1:

Referring to claim 1, it recites a contents distribution system comprising: a contents provider that comprises a contents server and a user information database and that distributes contents to a subscriber over a communication network, said contents server storing therein authored contents, said user information database having an area in which subscriber's contents download information and right information are recorded; and (See Fig.1, Fig. 2, Fig. 9A, col. 2, lines 55-60).

a portable terminal player, owned by the subscriber, that comprises a recording medium playback function playing back the contents downloaded to a recording

medium and a playback right return function returning a playback right back to said contents provider, said playback right allowing the subscriber to play back the downloaded contents, (See Fig. 9A; col. 14 line 63; col. 12, lines 9-25).

wherein said contents provider manages contents distribution to the subscriber in such a way that, when the contents are distributed to said portable terminal player of the subscriber, said contents provider manages a number of downloads of the contents to the subscriber and, when the subscriber returns the playback right of the distributed contents back to said contents provider, said portable terminal player erases a key for playing back the contents and a file name recorded on the recording medium and, at the same time, returns the playback right to the area in which the right information is recorded in said user information database. (See col. 7, lines 28-36).

Hasegawa teaches an apparatus for making sample contents from music contents whereby server and user are connected with each other via a communication network. Although Hasegawa does disclose a portable terminal player, it does not however expressly disclosed that the terminal is owned by the subscriber, and which erases a key for playing back the contents. However, Rhoads discloses a terminal player owned by the subscriber, which erases a key for playing back the contents. (See Fig. 1; col. 8, lines 31-32; col. 13, lines 46-51; col. 14, lines 37-52).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to use the apparatus for making sample contents taught by Hasegawa with the copy-proof disclosed by Rhoads because it would provide usage control restriction from a watermark and control playback.

Claim 2:

Referring to claim 2, it recites A contents distribution system comprising: a contents provider that comprises a contents server and a user information database and that distributes contents to a subscriber over a communication network according to an SDMI (Secure Digital Music Initiative) check-in/check-out rule, said contents server storing therein authored contents, said user information database having an area in which subscriber's contents download information and right information are recorded; and (See Fig.1, Fig. 2, Fig. 9A, col. 2, lines 55-60)

a portable terminal player, owned by the subscriber, that comprises a recording medium playback function playing back the contents downloaded to a recording medium and a check-in function returning a playback right back to said contents provider, said playback right allowing the subscriber to play back the downloaded contents, (See col. 12, lines 9-25).

wherein said contents provider manages contents distribution to the subscriber according to the SDMI check-in/check-out rule in such away that, when the contents are distributed to said portable terminal player of the subscriber, said contents provider manages a number of check-outs of the contents to the subscriber and, when the subscriber checks in the distributed contents, said portable terminal player erases a key for playing back the contents and a file name and, at the same time, returns the playback right to the area in which the right information is recorded in said user information database. (See col. 7, lines 28-36; col. 11, lines 28-67).

Hasegawa teaches an apparatus for making sample contents from music contents whereby server and user are connected with each other via a communication network. Although Hasegawa does disclose a portable terminal player, it does not however expressly disclosed that the terminal is owned by the subscriber and which erases a key for playing back the contents. However, Rhoads discloses SDMI and a portable terminal player owned by the subscriber, which erases a key for playing back the contents. (See Fig. 1; col. 4, lines 45-49; col. 8, lines 31-32; col. 13, lines 46-51; col. 14, lines 37-52).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to use the apparatus for making sample contents taught by Hasegawa with the copy-proof using SDMI disclosed by Rhoads because it would be useful in protecting the rights of the content supplier and copyright holder.

Claim 3:

Referring to claim 3, it recites a contents distribution system comprising: a contents provider that comprises a contents server and a user information database and that distributes contents to a subscriber over a communication network and saves and distributes user-migrated contents into and from the contents server, said user information database having an area in which subscriber's contents download information and right information are recorded; and (See Fig.1, Fig. 2, Fig. 9A, col. 2, lines 55-60).

a portable terminal player, owned by the subscriber, that comprises a recording medium playback function playing back the contents downloaded to a recording

medium and a check-in function returning a playback right back to said contents provider, said playback right allowing the subscriber to play back the downloaded contents, (See col. 12, lines 9-25).

wherein, when the subscriber migrates ripped contents to the contents server of said contents provider from said portable terminal player according to an SDMI rule, said contents provider manages a distribution of the migrated contents to the subscriber according to the SDMI check-in/check-out rule. (See col. 7, lines 28-36; col. 11, lines 28-67).

Hasegawa teaches an apparatus for making sample contents from music contents whereby server and user are connected with each other via a communication network. Although Hasegawa does disclose a portable terminal player, it does not however expressly disclosed that the terminal is owned by the subscriber, and which erases a key for playing back the contents using SDMI. However, Rhoads discloses SDMI and a portable terminal player owned by the subscriber, which erases a key for playing back the contents. (See Fig. 1; col. 4, lines 45-49; col. 8, lines 31-32; col. 13, lines 46-51; col. 14, lines 37-52).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to use the apparatus for making sample contents taught by Hasegawa with the copy-proof using SDMI disclosed by Rhoads because it would be useful in protecting the rights of the content supplier and copyright holder.



Claim 4:

Referring to claim 4, it recites a contents distribution system comprising: a contents provider that comprises a contents server storing therein authored contents and that supplies the contents to a contents distributor; (See Fig. 1, Fig.2)

the contents distributor that comprises a distribution contents server in which the contents supplied from said contents provider are stored and a user information database having an area in which subscriber's contents download information and right information are recorded and that distributes the contents to a subscriber; and (See Fig.1, Fig. 2)

a portable terminal player, owned by the subscriber, that comprises a recording medium playback function playing back the contents distributed from said contents distributor and downloaded to a recording medium and a check-in function returning a playback right back to said contents distributor, said playback right allowing the subscriber to play back the downloaded contents, (See col. 11, lines 29-54).

wherein said contents distributor manages contents distribution from said distribution contents server to said portable terminal player according to an SDMI check-in/check-out rule in such a way that, when the contents are distributed to said portable terminal player of the subscriber, said contents distributor manages a number of check-outs of the contents to the subscriber and, when the subscriber checks in the distributed contents to said contents distributor, said portable terminal player erases a key for playing back the contents and a file name and, at the same time, returns the

playback right to the area in which the right information is recorded in said user information database. (See Fig. 9A; col 14, line 63; col. 7, lines 28-39).

Hasegawa teaches an apparatus for making sample contents from music contents whereby server and user are connected with each other via a communication network and portable terminal player. Although Hasegawa does disclose a portable terminal player, it does not however expressly disclosed that the terminal is owned by the subscriber and which erases a key for playing back the contents using SDMI. However, Rhoads discloses contents distributor, SDMI and a portable terminal player owned by the subscriber, which erases a key for playing back the contents. (See Fig. 1, Fig. 2; col. 4, lines 45-49; col. 8, lines 31-32; col. 13, lines 46-51; col. 14, lines 37-52).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to use the apparatus for making sample contents taught by Hasegawa with the copy-proof using SDMI disclosed by Rhoads because it would be useful in protecting the rights of the content distributor and copyright holder.

Claim 5:

Referring to claim 5, it recites the contents distribution system according to claim 4, wherein the contents distributor further comprises a user contents server in which contents ripped by the subscriber are stored and, when the subscriber directly transmits the contents to said user contents server while ripping and compressing the contents or migrates the contents that have been recorded in the recording medium according to the SDMI rule, said contents distributor manages contents distribution from said user

contents server to the subscriber's portable terminal player according to the SDMI check-in/check-out rule. (See Fig. 1, Fig. 2 and Fig 9A, col. 14, line 63).

Hasegawa teaches a user contents server and contents compression and portable terminal player. Hasegawa does not expressly disclose contents distributor, a portable terminal player owned by the subscriber, and which erases a key for playing back the contents using SDMI. However, Rhoads discloses contents distributor, SDMI and a portable terminal player owned by the subscriber, which erases a key for playing back the contents. (See Fig. 1, Fig. 2; col. 4, lines 45-49; col. 8, lines 31-32; col. 13, lines 46-51; col. 14, lines 37-52).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to use the apparatus for making sample contents taught by Hasegawa with the copy-proof using SDMI disclosed by Rhoads because it would be useful in protecting the rights of the content distributor and copyright holder.

Claims 6-9:

As to claims 6-9, they recite the same limitations as claims 1-5. These claims do not teach or define any significantly new limitations above and beyond claims 1-5. Therefore, they do not warrant particular treatment, and are rejected for the same reasons.

**Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Janky (U.S. 5,914,941) teaches "Portable Information Storage/Playback Apparatus Having Data Interface."

Applicant is advised that Janky could have been used as a secondary reference to reject applicant's invention. (See Fig. 1-5; col. 3 and 4).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel Coffy whose telephone number is (703) 305-0325. The examiner can normally be reached on 8:30 - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Emmanuel Coffy  
Patent Examiner  
Art Unit 2157

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EC  
October 5, 2004

  
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